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**DEC 16 2004**

**OFFICE OF PETITIONS**

In re Application of :  
Geen, John A. :  
Application No. 10/646,332 : DECISION GRANTING PETITION  
Filed: August 22, 2003 : UNDER 37 CFR 1.78(a)(6)  
Attorney Docket No. 2550/189 :

This is a decision on the petition under 37 CFR 1.78(a)(6), filed August 23, 2004, to accept an unintentionally delayed claim under 35 U.S.C. §119(e) for the benefit of the prior-filed provisional applications.

The petition is **GRANTED**.

A petition under 37 CFR 1.78(a)(6) is only applicable to those applications filed on or after November 29, 2000. Further, the petition is appropriate only after expiration of the period specified in 37 CFR 1.78(a)(5)(ii) and must be filed during the pendency of the nonprovisional application. In addition, the petition must be accompanied by:

- (1) the reference required by 35 U.S.C. § 119(e) and 37 CFR 1.78(a)(5)(i) to the prior-filed application, unless previously submitted;
- (2) the surcharge set forth in § 1.17(t); and
- (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(5)(ii) and the date the claim was filed was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional.

The intermediate nonprovisional application was filed on February 6, 2003, within twelve months of the filing date of the prior-filed provisional applications, Application Nos. 60/354,610 and 60/364,322, which were filed on February 6, 2002 and March 14, 2002, respectively, for which priority is claimed. A reference to the prior-filed provisional applications has been included in an amendment to the first sentence of the specification following the title.

The instant nonprovisional application was filed after November 29, 2000, and the claim for priority herein is submitted after expiration of the period specified in 37 CFR 1.78(a)(5)(ii). Also, the reference to the prior-filed provisional applications was submitted during the pendency of the nonprovisional application for which the benefit is sought. *See* 35 U.S.C. §119(e). Accordingly, having found that the instant petition satisfies the conditions of 37 CFR 1.78(a)(6) for acceptance of an unintentionally delayed claim for priority under 35 U.S.C. §119(e), the petition to accept an unintentionally delayed claim of benefit to prior-filed provisional Application Nos. 60/354,610 and 60/364,322 is granted.

*The granting of the petition to accept the delayed benefit claim to the prior-filed applications under 37 CFR 1.78(a)(6) should not be construed as meaning that the instant application is entitled to the benefit of the filing date of the prior-filed applications. In order for the instant application to be entitled to the benefit of the prior-filed applications, all other requirements under 35 U.S.C. §119(e) and 37 CFR 1.78(a)(4) and (a)(5) must be met. Similarly, the fact that the corrected Filing Receipt accompanying this decision on petition includes the prior-filed applications should not be construed as meaning that applicant is entitled to the claim for benefit of priority to the prior-filed applications noted thereon. Accordingly, the examiner will, in due course, consider this benefit claim and determine whether the instant application is entitled to the benefit of the earlier filing date.*


A corrected Filing Receipt, which includes the priority claim to the above-noted, prior-filed provisional applications, accompanies this decision on petition.

Further, a reference to add the above-noted, prior-filed provisional application on page one following the first sentence of the specification has been included in an amendment filed on August 23, 2004. However, the amendment is not acceptable as drafted since it improperly incorporates by reference the prior application. Petitioner's attention is directed to Dart Industries v. Banner, 636 F.2d 684, 207 USPQ 273 (C.A.D.C. 1980), where the court drew a distinction between a permissible 35 U.S.C. § 120 statement and the impermissible introduction of new matter by way of incorporation by reference in a 35 U.S.C. § 120 statement. Therefore, the incorporation herein by reference statement included in the amendment filed with the instant petition is not proper, since at the time of filing the instant application, the correct provisional application number was not included. However, the Office will accept the priority claim as shown in the application data sheet filed on August 23, 2004.

Accordingly, petitioner is advised to submit a substitute amendment deleting the incorporation by reference statement to provisional Application Nos. 60/354,610 and 60/364,322, filed on February 6, 2002 and March 14, 2002, respectively.

Any inquiries concerning this decision may be directed to Paralegal Liana Chase at (571) 272-3206.

This matter is being referred to the Office of Initial Patent Examination for pre-exam processing. Afterwards, this matter will be referred to Technology Center AU 3682 for examination and consideration by the examiner of the claim under 35 U.S.C. §119(e) for the benefit of priority to prior-filed provisional applications.

  
Frances Hicks  
Petitions Examiner  
Office of Petitions  
Office of the Deputy Commissioner  
for Patent Examination Policy

ATTACHMENT: Corrected Filing Receipt